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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|---|-------------|----------------------|-----------------------------|------------------------|
| 10/602,426  | 06/24/2003  | Phillip Clark        | MCA-640                     | 9664                   |
| 25182 7590 07/12/2007<br>MILLIPORE CORPORATION<br>290 CONCORD ROAD<br>BILLERICA, MA 01821 |             |                      | EXAMINER<br>HANDY, DWAYNE K |                        |
|   |             |                      | ART UNIT<br>1743            | PAPER NUMBER           |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/602,426

Applicant(s)

CLARK ET AL.

Examiner

Dwayne K. Handy

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-22 are rejected under 35 U.S.C. 112 first paragraph, because the specification, while being enabling for the previously claimed elements, does not reasonably provide enablement for the new limitation of the first sample processing device being "uncovered". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Applicant has amended claim 1 to recite "a first sample processing device which is uncovered". This feature lacks enablement in the embodiment of the device recited in claim 1. Applicant has directed the Examiner to Figures 1-6 and page 14 of the Specification as support for this limitation. Many of these Figures (1-4B), however, appear to show embodiments in which the collar covers the side portions of the processing device and also where a top portion of the collar (14) extends inward to at least partially cover the top of the first sample processing device. In addition, the embodiment of Figure 1 includes an inner ledge (79) which clearly extends inward over the processing device as well (Specification, page 8, lines 17-18). The Examiner notes that Figures 5 and 6 appear to show a device in which the sample processing device is

placed on the top of the collar (page 15, lines 18–27). This may meet the limitation of uncovered. In this embodiment of the device described on page 15 and cited by the Examiner, however, the collection plate is not used. It appears to the Examiner, then, that the embodiment in which the first sample processing device is placed completely on top of and outside the collar is an embodiment that does not include the collection plate. Therefore, any embodiment claimed by Applicant that includes the collection plate may not also recite “a first sample processing device which is uncovered”.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In addition to the enablement rejection above, the Examiner submits that the “uncovered” limitation is also unclear. As noted above, Applicant has cited Figures 1-6 as support for the limitation. Several of these embodiments show the collar covering the sides and a top surface of the collar that extends inward to at least partially cover the top of the first sample processing device. Given that these embodiments appears to show a covered processing device and Applicant has not directed to the Examiner to any portion of the Specification which describes what feature of the device is required to meet the limitation of “uncovered”,

Art Unit: 1743

the Examiner submits that it is unclear as to how much of the processing device must be contacted or otherwise sheltered by the collar in order to meet this limitation.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5-9, 11, 12 and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated Moring et al. (6,159,368). This rejection was upheld in the previous Office Action (mailed 1/17/07). It remains in effect. Please see Response to Argument below.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1743

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moring et al. (6,159,368) in view of Vestal (5,498,545). This rejection was upheld in the previous Office Action (mailed 1/17/07). It remains in effect. Please see Response to Argument below

### ***Response to Arguments***

9. Applicant has argued the following in traversing the previous rejections: (A) Moring does not teach an uncovered first processing device; (B) Moring does not teach all of the features of the rejected method claims; and (C) The combination of Vestal with Moring lacks motivation and requires hindsight. The Examiner respectfully disagrees on all counts.

#### **(A) Moring device claims**

Applicant has argued that Morning does not anticipate the claims since Moring does not teach a first sample processing device that is uncovered. The Examiner takes the position that this argument is moot since this feature lacks enablement in the claimed device. See Paragraph 2 above.

Art Unit: 1743

(B) Moring method claims

Applicant has argued that Moring does not anticipate the method claims because Moring does not teach the limitations of claim 16. Claim 16 recites “applying a vacuum to said manifold with said vacuum source, whereby said collar is forced into sealing engagement with said base without causing movement of said sample unit.” Applicant has argued that because Moring teaches that the gaskets are already compressed, then the collar can not be forced into sealing engagement by vacuum. First, Applicant is arguing a bit beyond the scope of the claim. In addition, the Examiner notes there is nothing that precludes the application of vacuum force in addition to the compression force already applied by Moring. The Examiner cited the compression force in arguing with Applicant about movement of the sample processing unit – not the sealing engagement between the collar and base as is being argued now.

Applicant appears to be arguing that the collar moves in response to the vacuum (“The claim recites a step whereby the vacuum forces the collar into sealing engagement”). This is not in the claim. The claim requires that the collar is forced into a sealing engagement. This would include the mere application of vacuum to the housing. The Examiner submits that the application of vacuum would provide a force that yields a sealing engagement between the collar and base. This is in addition to the compression force already applied to the gaskets. The collar would then be subjected to two forces – compression and vacuum. In addition, since the gaskets are already compressed (As argued by the Examiner and noted by Applicant) the collar would

receive the vacuum force, be in sealing engagement with the base – and not move the sample processing unit as required by the claim.

(C) Vestal and Moring

Applicant has argued that the combination of Vestal with Moring lacks motivation and requires hindsight. The Examiner respectfully disagrees and submits that the use of a multiwell plate as the collection plate in a filtering device is a notoriously common use of the plate. In addition, one of ordinary skill in the art would recognize the desirability of analyzing the contents of a filtered sample. Vestal teaches a multiwell plate that is used to analyze sample in a MALDI system. The Examiner submits that no hindsight is required to recognize that the multiwell plate of Vestal would be useful to collect samples that may then be transferred to the MALDI system for analysis. Collecting the samples and then analyzing them in a single plate would speed analysis time.

***Allowable Subject Matter***

10. Claims 23 and 24 are allowed. Claim 23 was deemed allowable in the previous Office Action. Claim 24 contains the feature of the top surface of the first sample processing device being below the top surface of the collar. This feature was not shown in the prior art.



***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH  
July 9, 2007



JAN LUDLOW  
PRIMARY EXAMINER